



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/655,928	09/05/2003	Bertold Gruetzmacher	600.1243	8625
23280	7590	06/03/2005		
DAVIDSON, DAVIDSON & KAPPEL, LLC 485 SEVENTH AVENUE, 14TH FLOOR NEW YORK, NY 10018			EXAMINER WILLIAMS, KEVIN D	
			ART UNIT	PAPER NUMBER
			2854	

DATE MAILED: 06/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/655,928

Applicant(s)

GRUETZMACHER ET AL.

Examiner

Kevin D. Williams

Art Unit

2854

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 March 2005.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
4a) Of the above claim(s) 10-17 is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-9 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 05 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 9/5/2003.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Claims 10-17 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 3/9/2005.

Applicant argues that the product in claim 1 can not be made by a process materially different from the process of claims 10 and 15. The product in claim 1 does not require that the coating include or be applied by an aqueous or alcoholic solution. Therefore, the coating of claim 1 can be applied by a process that does not treat the coated surface with an aqueous or alcoholic solution.

The restriction requirement is repeated here and made final.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 4, and 7-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wirz (US 5,479,856) in view of Mohr (US 4,427,766).

Wirz teaches a printing press having print substrate-contacting element (col. 2, lines 50-52) comprising a microstructured carrier having a surface, an ink-repellent coating on the surface of the microstructured carrier, the print substrate-contacting element being a back-pressure cylinder or a part of a surface thereof.

Wirz does not teach the ink repellent coating including a derivative of an amphiphilic organic compound having a polar region with an acidic character, the derivative of an amphiphilic organic compound being a hydroxamic acid derivative or a phosphonic acid derivative.

Mohr teaches an ink repellent coating including a derivative of an amphiphilic organic compound having a polar region with an acidic character, the derivative of an amphiphilic organic compound being a hydroxamic acid derivative or a phosphonic acid derivative (col. 17, lines 17-21).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Wirz to have the phosphonic acid derivative as taught by Mohr, in order to improve the ink repellent qualities of the coating.

4. Claims 2 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wirz in view of Mohr as applied to claims 1, 4, and 7-9 above, and further in view of Tomita (US 2002/0062748).

Wirz in view of Mohr teaches the claimed invention except for the carrier being metallic, having a natively oxidized surface and having at least one substance selected from the group consisting of titanium, zirconium, molybdenum, nickel, copper, aluminum, chromium, iron, silver and gold.

Tomita teaches a carrier being metallic, having a natively oxidized surface and having at least one substance selected from the group consisting of titanium, zirconium, molybdenum, nickel, copper, aluminum, chromium, iron, silver and gold ([0031]).

5. Claims 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wirz in view of Mohr as applied to claims 1, 4, and 7-9 above, and further in view of Boardman (US 6,824,882).

Wirz in view of Mohr teaches the claimed invention except for the derivative of the amphiphilic organic compound being substituted in a nonpolar region so as to be both ink-repellent and water-repellent, and the derivative of the amphiphilic organic compound being fluorinated in a nonpolar region.

Boardman teaches a derivative of the amphiphilic organic compound being substituted in a nonpolar region so as to be both ink-repellent and water-repellent, and the derivative of the amphiphilic organic compound being fluorinated in a nonpolar region (col. 4, line 66 to col. 5, line 3).

It would have been obvious to one of ordinary skill in the art at the time of the invention to additionally modify Wirz to have the fluorinated phosphonic acid as taught by Boardman, in order to protect the print substrate contacting element by increasing the repellent action of the coating.

Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin D. Williams whose telephone number is (571)


Art Unit: 2854

272-2172. The examiner can normally be reached on Monday - Friday, 8:30am - 6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew H. Hirshfeld can be reached on (571) 272-2168. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KDW
May 30, 2005



ANDREW H. HIRSHFELD
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2800